

REMARKS/ARGUMENTS

Claims 1-5, 7, 8, 12-14, 16-18, 22, 23, and 25 were presented for examination and are pending in this application. In an Official Office Action dated April 19, 2007, claims 1-5, 7, 8, 12-14, 16-18, 22, 23, and 25 were rejected. The Applicant thanks the Examiner for his consideration and addresses the Examiner's comments concerning the claims pending in this application below.

Applicant herein amends claims 1 and 7 and respectfully traverses the Examiner's prior rejections. These changes are believed not to introduce new matter, and their entry is respectfully requested. The claims have been amended to expedite the prosecution and issuance of the application. In making this amendment, the Applicant has not and is not narrowing the scope of the protection to which the Applicant considers the claimed invention to be entitled and does not concede, directly or by implication, that the subject matter of such claims was in fact disclosed or taught by the cited prior art. Rather, the Applicant reserves the right to pursue such protection at a later point in time and merely seeks to pursue protection for the subject matter presented in this submission.

Based on the above amendment and the following remarks, Applicant respectfully requests that the Examiner reconsider all outstanding rejections and withdraw them.

Information Disclosure Statement

The Examiner indicated that the Information Disclosure Statement (IDS) filed on 9 February 2001 was not considered as it fails to list its contents. The Applicant draws the Examiner's attention to the Official Office Action of December 30, 2003 in which the Examiner of Record, William H. Wood initialed each art listed on the above-referenced IDS and signed the IDS on November 20, 2003 indicating that each citation was considered.

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The Applicant contends that the IDS submitted on 9 February 2001 was in compliance with both 37 CFR 1.97 and 37 CFR 1.98. Each patent listed on the USPTO form 1449 (the proper form in 2001) includes the patent number, inventor and issue date. The application number of the application was not indicated on the IDS, as specified in section (a)(1)(i) because at the time of filing, no application number was yet issued. Furthermore, a copy of each U.S. Patent referenced in the IDS was provided as is evidenced by the return receipt postcard dated 9 February 2001 and received back to our office on March 7, 2001 identifying that the filing package included copies of the 5 cited references.

Furthermore, the filed USPTO form 1449, filed on 9 February, 2001 was initialed and signed by the Examiner. As indicated by MPEP 609, the Examiner is obligated to consider the information in the same manner as other documents in the Office search files by the Examiner while conducting a search of the prior art in a proper field of search. If the art had not been considered, each non-considered item should have been lined through as directed by MPEP 609.01. In addition and as stated in section MPEP 609.05(b) the initials of the Examiner on the PTO/SB/08A or its equivalent (USPTO form 1449) mean that the information contained in the IDS complies with both 37 CFR 1.97 and 37 CFR 1.98 and that the Examiner will consider the documents in same manner as other documents in Office search files are considered by the Examiner while conducting a search of the prior art in a proper field of search.

An issued patent carries with it a presumed validity over each piece of art considered (initialed) by the Examiner. This is a strong presumption that has been reinforced in the judicial system several times over. To look back some four years and indicate that previously considered art was in fact not considered would undermine this presumption. Just as statements made by an Applicant during prosecution are binding and produce prosecution estoppel, so are the actions of an Examiner. The Examiner's new rejection based on a previously

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submitted and considered IDS of four years ago would severely prejudice the Applicant. This dismissal of a previously submitted, considered, and initialed IDS is improper.

35 U.S.C. §101 Rejection of Claims

Claims 18 and 22 were rejected under 35 U.S.C. § 101, as being non-statutory subject matter. Specifically, claim 18 as directed to a network system is asserted as being software per se. The Applicant traverses this conclusion. The first element of claim 18 states, “a managed host in the operating computer system linked to a communications network, the managed host including a survey tool for automatically gathering environment information and an installation tool for transmitting the environment information over the communications network and for automatically installing systems management software on the managed host...” Taking this limitation in its broadest interpretation, and in light of the specification, it is clear that the host is a hardware component associated with a network. How else could systems management software be installed on “the host”. The Office Action cites that “claim 18 recites a ‘network system’ which does not necessarily contain hardware.” However, as discussed above, claim 18 clearly does contain hardware. Withdrawal of the rejection is requested.

35 U.S.C. §112 Rejection of Claims

Claims 1-5 were rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement. Specifically, claims 1-5 each contain the word “after” which the present Office Action contends is not described in the specification. The Applicant disagrees. The Applicant draws the Examiner’s attention at least to the paragraphs beginning on line 17 of page 5 and line 1 on page 6. The paragraph on page 6 states in part, “In one embodiment, the payload contents are selected based on the computing

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environment information. Next, the installation tool acts automatically to install the software payload on the host device and to configure the installed software payload based on the computing environment information.” Clearly installation of the software payload occurs “after” receiving computer environment information. The paragraph on page 5 also discloses the chronological relationship of the transmission of the software payload. Put simply, the term “after” is used to represent a chronological order.

In good faith the Applicant amends the above referenced claims to replace the term “after” with “responsive to”. Reconsideration is respectfully requested.

Rejection of the Claims under 35 U.S.C. §102(e)

Claims 1-5 were rejected under 35 U.S.C. §102(e) as being anticipated by U.S. Patent No. 6,009,274 by Fletcher et al. (“Fletcher”). Applicant respectfully traverses these rejections in light of the following remarks.

MPEP §2131 provides:

“A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” *Verdegall Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 U.S.P.Q.2d 1051, 1053 (Fed. Cir.1987). “The identical invention must be shown in as complete detail as contained in the claim.” *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 U.S.P.Q.2d 1913, 1920 (Fed. Cir. 1989).

The claims as currently amended recite features lacking in the applied references. For example, independent claim 1 (and in varying language claims 7, 18 and 23) recites, among other things, “responsive to the receiving of the

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computing environment information, loading an installation tool configured to automatically install the systems management software on the host device [and] responsive to the loading of the installation tool, transmitting a software payload comprising the systems management software from the installation station to the host device....” Fletcher fails to disclose at least these elements of the present invention.

Fletcher appears to disclose methods and systems for updating software utilizing agents on the host. See Fletcher col. 5, lines, 5-10. These agents request and receive files for the host. Id. col. 5, lines 35-45. The agent communicates with a down-load-module to transmit and execute at the agent (host) a “self extracting compressed file with an installer and the needed files within it.” Id col. 9, lines 20-24. Thus the installation tool does not receive a payload. The installation tool is part of the payload.

Fletcher is a host-based system that is distinct from the presently claimed invention. The present invention is not host-based but rather involves communicatively linking an installation station with the host device and receiving at the installation station computing environment information for the host. The installation station then transmits an installation tool configured for automatically installing the system management software to the host device. The Applicant thus deems claims 1, 7, 18 and 23, as well as those claims that depend therefrom, not anticipated by Fletcher. Reconsideration is respectfully requested.

35 U.S.C. §103(a) Obviousness Rejection of Claims

Claims 5, 14 and 16-17 were rejected under 35 U.S.C. §103(a) as being unpatentable over Fletcher in view of Applicant Admitted Prior Art (“APA”). Claim 13 is rejected under 35 U.S.C. §103(a) as being unpatentable over Fletcher in view of Microsoft Computer Dictionary. Claim 22 is rejected under 35

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U.S.C. §103(a) as being unpatentable over Fletcher in view of U.S. Patent No. 6,434,532 by Goldband et al (“Goldband”). Finally, claim 25 is rejected under 35 U.S.C. §103(a) as being unpatentable over Fletcher in view of U.S. Patent No. 5,421,009 by Platt (“Platt”). Applicant respectfully traverses these rejections in light of the aforementioned remarks and respectfully requests reconsideration.

The cited references fail to teach or suggest all of the limitations recited in the claims as currently amended. For example, independent claim 14 recites, among other things, “downloading an installation Daemon from the installation station onto the network computer device; using the installation Daemon to retrieve the output file and transfer a copy of the output file to the installation station; [and in response to receiving the copy, transferring the agent software to the network computer device over the communications network....”

As previously discussed Fletcher is a host-based system. This is distinct from the present invention. The updated agent cited in col. 9, lines 17-29 of Fletcher is a host-based agent that requests a self-extracting file that includes an installer and the files to be installed. The “updated agent” of Fletcher does not teach or suggest the present invention. For at least these reasons, the Applicant deems claim 14 and those claims that depend therefrom, patentable over Fletcher in view of APA. Similarly, claim 5 is also deemed patentable over Fletcher in view of APA for at least the same reasons. Reconsideration is respectfully requested.

The Applicant also deems claims 13, 22, and 25 to be patentable over Fletcher in view of, respectively, Microsoft Computer Dictionary, Goldband and Platt for at least the same reason presented above. Neither the Microsoft Computer Dictionary nor Goldband nor Platt resolve the deficiencies of Fletcher. Reconsideration is requested.

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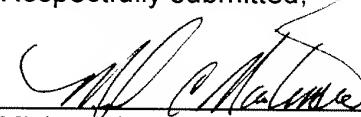
Conclusion

In view of all of the above, the claims are now believed to be allowable and the case in condition for allowance which action is respectfully requested. Should the Examiner be of the opinion that a telephone conference would expedite the prosecution of this case, the Examiner is requested to contact Applicant's attorney at the telephone number listed below.

No fee is believed due for this submittal. However, any fee deficiency associated with this submittal may be charged to Deposit Account No. 50-1123.

Respectfully submitted,

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